



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,914	11/16/2000	Euphrason Rebello	367.39277X00	5948
22907 7590 07/17/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER TRAN, PABLO N	
			ART UNIT 2618	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/712,914

Applicant(s)

REBELLO, EUPHRASON

Examiner

Pablo N. Tran

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding the claimed limitation, "wherein in the first configuration, the radiotelephone is activated and is arranged to receive telephone calls" render the claim indefinite. Is it in the first or second configuration, the phone is activated and is arranged to receive telephone calls. The examiner will interpret the claim as "in the second configuration the radio telephone is activated and is arranged to receive telephone calls" and examined as such. Appropriated correction required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7, 9-14, 16, 18-21, 23-27, 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker (6,124,799).

As per claims 1, 10, and 23, Parker discloses a communication device (fig. 2/no. 20) addressable with reference to identification data (fig. 2/no. 42) and including memory locations (fig. 2/no. 40) for storing the identification data having a processor (fig. 2/no. 22), responsive to a first code (fig. 2/no. 32), for controlling the storage of the identification data in the memory location, the processor being responsive to an incoming signal (fig. 4/no. 114, col. 8/ln. 49-col. 9/ln. 10) addressing the communication device with reference to the stored identification data to change the first code for subsequently controlling the storage of the identification data in the memory location (fig. 4, fig. 5, fig. 10, col. 8/ln. 16-col. 11/ln. 58).

As per claims 2, 11, 24, and 26, Parker discloses the identification data identifying a particular provider (col. 6/ln. 17-18).

As per claims 3, 12, 20, and 29, Parker discloses the communication device is a radio telephone (fig. 2/no. 20) and the incoming signal addressing the device is the first call received by the device having a new identity (col. 8/ln. 49-col. 9/ln. 10).

As per claims 4, 13, and 21, Parker discloses second code is stored in the phone to which the first code is changed (col. 8/ln. 16-col. 11/ln. 58).

As per claims 5 and 14, Parker discloses the second code is specific to the phone (col. 8/ln. 16-col. 11/ln. 58).

As per claims 7 and 16, Parker discloses the first code is specific to the communication device (col. 7/ln. 59-col. 8/ln. 7).

As per claims 9 and 18, Parker discloses the identification data includes MIN data (col. 1/ln. 58-col. 2/ln. 38).

As per claims 25, as stated above in claim 1, Parker further discloses means for changing the configuration of the communication device from a first configuration to a second configuration and wherein, in the first configuration, a first code is required to program the identification data and in the second configuration a second code, different from the first code, is required to program the identification data (col. 8/ln. 16-col. 11/ln. 58).

As per claim 27, Parker discloses the identification data is programmed by a user (col. 8/ln. 16-col. 11/ln. 58).

As per claims 30 and 32, Parker discloses in the second configuration the radiotelephone is activated and is arranged to receive telephone calls (col. 8/ln. 16-col. 11/ln. 58).

As per claim 31, Parker discloses in the first configuration, the radiotelephone is deactivated and is prevented from receiving telephone calls (col. 8/ln. 16-col. 11/ln. 58).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 8, 15, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker (6,124,799).

As per claims 6, 8, 15, and 17, Parker does not specifically suggest such random method of generating the first or second code. However, such method is notoriously well known in the art that the examiner takes Official Notice of such. Therefore, it would have been obvious to one of ordinary skill in the art to provide such method, well known, to the method of activating a communication device of Parker in order to provide a secure method of generate sensitive data.

As per claim 22, Parker does not suggested that a second code is stored in the device prior to programming. However, such method is disclosed in the background of Parker (col. 2/ln. 30-50). Therefore, it would have been obvious to one of ordinary skill in the art to provide such method, to the communication device of Parker in order to effectively un-locked and activated the mobile devices enabling the user to make telephone calls.

7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker (6,124,799) in view of Fielden (6,314,283).

As per claim 28, Parker disclosed such first code but not specifically that the first code is input by a user. However, such method is well known in the art, as taught by Fielden (col. 5/ln. 43-55). Therefore, it would have been obvious to one of ordinary skill in the art to provide such method of inputting sensitive data, as taught by Fielden, to the

method of activating a communication device of Parker in order to provide such convenient and flexibility method of programming the mobile telephone.

Response to Arguments

8. Applicant's arguments filed 07/20/06 have been fully considered but they are not persuasive.

The Applicant's stated that, "the 112 rejection is improper". In response to the Applicant, according to the specification, the phone is de-activated and unable to receive calls in the first configuration and wherein after the phone has been programmed successfully the phone is able to receive calls (see specification, page 10, [0031]). Therefore, the rejection is proper.

The Applicant's stated that, "Parker does not teach or suggest the processor being responsive to an incoming signal addressing the communication device with reference to the stored identification data to change the first code for subsequently controlling the storage of the identification data in the memory locations". In response to the Applicant, Parker disclose a valid code is transmitted to the handset (col. 8/ln. 60-col. 9/ln. 10) and wherein the processor of the handset utilize the first valid code to begin authentication process (col. 9/ln. 19-col. 11/ln. 11) to derive a second valid code and store the second code (col. 13/ln. 25-col. 14/ln. 5). Furthermore, the applicant does not explicitly stated as to how the processor manipulated the storage locations of the memory. Therefore, given the broadest interpretation, the claim is read by parker.

The Applicant's stated that, "Parker does not teach or suggest entering a first code to enter a mode for programming the identification data". In response to the Applicant, Parker disclose a valid code is transmitted to the handset (col. 8/ln. 60-col. 9/ln. 10) and wherein the handset utilize the first valid code to begin authentication process (col. 9/ln. 19-col. 11/ln. 11) to derive a second valid code and store the second code (col. 13/ln. 25-col. 14/ln. 5). Therefore, the rejection is proper.

The Applicant's stated that, "Parker does not teach or suggest the claimed limitation of claim 25". In response to the Applicant, Parker discloses a valid code is transmitted to the handset (col. 8/ln. 60-col. 9/ln. 10) and wherein the handset utilized the first valid code to begin authentication process to unlocked (activate) the handset (col. 9/ln. 19-col. 11/ln. 11). Furthermore, Parker disclose that the handset can be re-locked by utilizing the modified the valid code for computation (col. 11/ln. 18-43). Therefore, the rejection is proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (571)272-7898. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directauspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**PABLO N. TRAN
PRIMARY EXAMINER**

July 7, 2007


